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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,721

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EXAMINER

HOUSTON, ELIZABETH

ART UNIT

PAPER NUMBER

3731

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/828,721	<b>Applicant(s)</b> ELLIS, LOUIS G.	
	<b>Examiner</b> ELIZABETH HOUSTON	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-42 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 27-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support provided in the specification for a "plurality of *linear* magnetic sections".

3. Furthermore, while being enabling for a system having an elongate shaft or a guidewire, does not reasonably provide enablement for a system having an elongate shaft and a guidewire. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 27-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. In claim 27, there is an inconsistency in the language of the preamble and that of the body of the claim thus making their scope unclear. The preamble recites "a captivation tool for use with an guidewire" with the guidewire only functionally recited, thus indicating that the Claims are directed to the subcombination captivation tool. However, line 6 states "*coupled* with at least one region of the guidewire", positively reciting the guidewire as an element of invention, thus indicating that the claims are directed to the combination of the captivation tool and guidewire. As such it is unclear whether applicant intends the claims to be drawn to the combination or the subcombination. Applicant is hereby required to indicate which, the combination (captivation tool with guidewire) or subcombination (captivation tool) the claims are intended to be drawn and make the language consistent with this intent. For examination purposes, the claims will be considered as drawn to the combination (captivation tool with guidewire).

7. In claim 27, there is an inconsistency in the language of the preamble and that of the body of the claim thus making their scope unclear. The preamble recites "a captivation tool" thus indicating that the claims are directed to the subcombination captivation tool. However, line 9 states "said catheter being generally *in contact* with at least the bottom surface", positively reciting the catheter as an element of invention, thus indicating that the claims are directed to the combination of the captivation tool and catheter. As such it is unclear whether applicant intends the claims to be drawn to the combination or the subcombination. Applicant is hereby required to indicate which, the combination (captivation tool with catheter) or subcombination (captivation tool) the

claims are intended to be drawn and make the language consistent with this intent. For examination purposes, the claims will be considered as drawn to the combination (captivation tool with catheter).

8. Claim 27 recites the limitation "the elongate shaft" in line 7. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 36 which is dependent from claim 34 recites the limitation "the plurality of regions". However claim 34 recites "magnetically coupled to a plurality of regions" and "a plurality of regions" ... "which are not magnetically coupled". It is therefore unclear which "plurality of regions" claim 36 is referring back to.

10. Claim 37 recites the limitation "the at least one region" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 27-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Thome (US 5,776,080).

13. Thome discloses a captivation tool (50, 100) for use with a guidewire comprising: a housing member (Figs. 5-7 and 18-20) having a first wall (62) and a second wall (64) and a bottom surface (66) therebetween defining a longitudinal slot (60); a plurality of

linear magnetic sections (72) disposed along and parallel to the slot (Fig. 6), whereby at least one of the plurality of magnetic sections is attractively magnetically coupled with at least one region of the guidewire (54) when said guidewire is disposed within the longitudinal slot to increase the force necessary to translate within the longitudinal slot when the elongate shaft (guidewire) is further contained within a surrounding catheter (42) (C7:L1-15; C12:L5-14), said catheter being generally in contact with at least the bottom surface of the longitudinal slot of the captivation tool (Fig. 7). The plurality of magnetic sections are disposed along the bottom surface and the first wall of the longitudinal slot (Fig. 20). The catheter may be moved generally along the magnetically coupled guidewire without dislodging the guidewire from the captivation tool (C7: L1-15). The plurality of magnetic sections of the captivation tool are magnetically coupled to a plurality of regions disposed along the guidewire. All of the magnetic couplings between the plurality of regions of the guidewire and the plurality of magnetic sections of the captivation tool are attractive (c8: L1-31). The plurality of magnetic sections are magnetically coupled to a plurality of regions (54) along the guidewire which alternate with a plurality of regions (53) of disposed along the guidewire which are not magnetically coupled to the plurality of magnetic sections. The size and spacing of the alternating coupled and not coupled regions disposed along the guidewire correspond to the spacing of the plurality of magnetic sections of the captivation tool (note that "correspond" does not require the sections of the guidewire and the sections of the captivation tool to be equally sized and spaced). The magnetic coupling between the plurality of magnetic sections and the plurality of regions (magnetically coupled) along

the guidewire may be established at a plurality of translational displacements of the guidewire with respect to the captivation tool (see Figs. 4 and 5). There is a catheter guide that has a guide opening disposed therethrough for receipt of a catheter (12, Fig. 18). The guidewire further comprises an embolic protection device. The surrounding catheter further comprises a retrieval sheath. The surrounding catheter further comprises a stent delivery catheter.

***Claim Rejections - 35 USC § 103***

14. Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thome in view of Boyle (US 6,939,362)

15. Thome does not disclose that there is an embolic protection filter disposed on the elongate shaft.

16. However, Boyle discloses that is old and well known in the art to incorporate a filter on an elongate shaft (guide wire) to be used with an angioplasty balloon or stent delivery catheter. The filter disposed on the elongate shaft prevents embolic particles from being released into the blood stream (C 2, L 65-C3, L10). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a filter into the angioplasty balloon catheter of Pflueger since it is well known in the art to use a filter to capture embolic particles that may be released into the blood stream as a result of the angioplasty procedure.

***Response to Arguments***

17. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH HOUSTON whose telephone number is (571)272-7134. The examiner can normally be reached on M-F 9:00-5:00.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. H./  
Examiner, Art Unit 3731

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3731